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OFFICE OF PETITIONS

PATENT

Customer Number 22,852

Attorney Docket No. 6530-0253-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Richard MONTALVO, et al.

Serial No.: 09/988,125

Filed: November 19, 2001

For: ENDOSCOPIC SURGICAL  
INSTRUMENT

Group Art Unit: 3739

Examiner: Unassigned

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R.**  
**§1.47(a) AND RENEWED PETITION UNDER 37 C.F.R. §1.47(a)**

This paper responds to the Decision Refusing Status under 37 C.F.R.

1.47(a) dated December 31, 2001 and submits a renewed petition, pursuant to 37 C.F.R. §1.47(a), for acceptance of this application on behalf of Applicants and one non-signing inventor. A period for response to the Decision has been extended through April 30, 2002 by the attached request for a two-month extension of time.

Since the original Rule 1.47(a) Petition filed on November 19, 2001 and the December 31, 2001 Decision Refusing Status, changed circumstances warrant a renewed Rule 1.47(a) Petition. These changed circumstances are set out in the enclosed Declaration in Support of Petition.

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04/19/2002 CNGUYEN  
02 FC:105  
04/19/2002 CNGUYEN  
03 FC:116

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130.00 DP

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400.00 DP

Adjustment date: 05/13/2002 AKELLEY  
04/19/2002 CNGUYEN 00000042 09988125  
01 FC:122 -130.00 DP  
Repl'n Ref: 05/13/2002 AKELLEY 0009562100  
DAH:060916 Name/Number:09988125  
FC: 704 \$130.00 CR

As the Patent Office states in the December 31, 2001 Decision, a grantable rule 47(a) petition requires: (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application; and (5) a statement of the last known address of the non-signing inventor. With this Petition, Applicants submit each of these elements.

First, Applicants submit a Declaration and Power of Attorney signed and dated by two of the three inventors. The signature of one inventor, Mr. Richard Montalvo, is missing because he refuses to sign the Declaration after having been presented with the application papers.

The enclosed Declaration in Support of Petition fully describes the facts, which establish that Mr. Montalvo was presented with the application papers and has refused to sign the Declaration. That Declaration also states the last known address of Mr. Montalvo in accordance with 37 C.F.R. §1.47(a).

A fee of \$130.00 for the petition under 37 C.F.R. §1.47(a) is enclosed, and a surcharge of \$130.00 is also enclosed.

Applicants therefore have provided all five (5) elements that the Patent Office has stated are required for a grantable Rule 47(a) Petition. If any other

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element is required, the Office is invited to contact the undersigned representative of Applicants at (202) 408-6057 and the element will be provided.

If there are any other fees due in connection with the filing of the Petition, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON,  
FARABOW, GARRETT & DUNNER,  
L.L.P.

Dated: April 18, 2002



Naoki Yoshida  
Reg. No. 48,108

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In re Application of: )  
Richard MONTALVO et al. ) Group Art Unit: 3739  
Application No.: 09/988,125 ) Examiner: Unassigned  
Filed: November 19, 2001 )  
For: ENDOSCOPIC SURGICAL )  
INSTRUMENT )

Commissioner for Patents  
Washington, DC 20231

Sir:

**DECLARATION IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(a)**

I, Kathleen Cronin, hereby declare as follows:

1. I am employed by Boston Scientific Corporation as a Patent Secretary. Boston Scientific Corporation is related to the assignee of the above application, Scimed Life Systems, Inc.
2. I understand that Mr. Richard Montalvo is a joint inventor along with Messrs. Curt Willem and Ceasar Escobar in the above-captioned patent application.
3. Mr. Montalvo's last known address is 8833 Lake Drive, Apartment L301, Miami, FL 33166, and his last known telephone number is 305-436-0578.
4. I sent a package with a copy of the above-identified application and a Declaration and Power of Attorney to Mr. Montalvo's last known address via Federal Express on March 1, 2002. As Exhibit A to this Declaration, I have attached a copy of the March 1, 2002 cover letter to Mr. Montalvo. That letter requests that Mr.

Montalvo sign and date the Declaration and return it to me. I also enclosed a self-addressed return Federal Express envelope for Mr. Montalvo and included my toll free telephone number if he had any questions.

5. Federal Express's tracking and delivery information, attached as Exhibit B, shows that the package was delivered to and signed for by Mr. Montalvo on March 4, 2002.

6. Since the delivery of the package, I have attempted to reach Mr. Montalvo by telephone on several occasions in an effort to have him sign and return the Declaration. Specifically, I called Mr. Montalvo on March 6<sup>th</sup>, March 13<sup>th</sup>, and March 21<sup>st</sup>, 2002, at his last known telephone number. All of my calls were answered by Mr. Montalvo's answering machine, which indicates that Mr. Montalvo resided at that telephone number. Each time, I left a detailed message on his answering machine asking him to sign and return the Declaration or return my call at the toll free number that he can call 24 hours a day. None of my calls was returned.

7. To date, Mr. Montalvo has not returned an executed Declaration.

8. To my knowledge, Mr. Richard Montalvo no longer works for Symbiosis Corporation (a company related to Boston Scientific Corporation and assignee Scimed Life Systems, Inc.) or any other company related to assignee. I am currently unaware of the place of his employment.

9. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: April 10, 2002

By: Kathleen Cronin  
Kathleen Cronin

**Boston  
Scientific**

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Boston Scientific Corporation  
One Boston Scientific Place  
Natick, MA 01760-1537  
508.650.8000  
www.bsci.com

March 1, 2002

**VIA FEDERAL EXPRESS**

7917 8717 7259

Richard Montalvo  
8833 Lake Drive  
Apartment L301  
Miami, FL 33166

RE: US Patent Application No. 09/603,886  
Title: "*Endoscopic Surgical Instrument*"  
Our Reference No.: 98-P0156US1

Dear Richard:

Enclosed please find a copy of the application as filed for the above-referenced patent application along with a Declaration and Power of Attorney document for your signature. Please sign and date where indicated and return to me at your earliest convenience.

I have enclosed a self-addressed return Federal Express(790328149447) envelope for your convenience.

If you have any questions, I can be reached at (800) 272-3737 ext. 8768.

Very truly yours,



Kathleen Cronin  
Patent Secretary

/kec  
Enclosure



## Ship Manager

## Shipment Tracking

FedEx has processed your shipment shown below. If you have any questions about this shipment, you can email us or contact your customer service representative.

**Tracking Number** 791787177259  
**Reference Number** 10032  
**Ship Date** 03/01/2002  
**Delivered To** Recipient  
**Delivery Location** MIAMI FL  
**Delivery Date/Time** 03/04/2002 12:05  
**Signed For By** R.MONTALVO  
**Service Type** Standard Letter

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Arrived at FedEx Destination Location MIAMI FL	03/02/2002 09:39	
Package status MIAMI FL	03/02/2002 09:39	Package not due for delivery
Package status MIAMI FL	03/02/2002 09:39	Package not due for delivery
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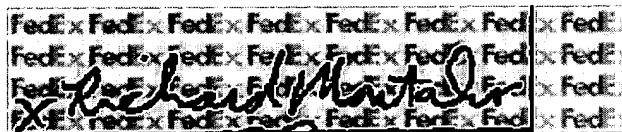
Here is the proof of delivery for the shipment with tracking number **791787177259**. Our records reflect the following information.

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**Delivery Information:**

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Signed For By: R.MONTALVO



Delivery Location: 8333 LAKE DRIVE APT 301

Delivery Date: March 4, 2002

Delivery Time: 1205

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**Shipping Information:**

---

Tracking No: 791787177259

Ship Date: March 1, 2002

**Recipient:**

RICHARD MONTALVO

8333 LAKE DRIVE

MIAMI, FL 33166

US

**Shipper:**

KATHLEEN CRONIN

BOSTON SCIENTIFIC/CORPORATE

1 BOSTON SCIENTIFIC PL

NATICK, MA 017601537

Shipment Reference Information:

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